IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Janssen et al.	: Confirmation No.: 9408
Application No.: 10/040,149	: Group Art Unit: 2153
Filed: January 2, 2002	: Examiner: Scuderi, Phillip S.
	: Attorney Docket No.:
For: SERVER-BASED COMPUTING ENVIRONMENT	: DVME-1018US

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Applicant requests review and withdrawal of all rejections in the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. Claims 1-10 and 18-19 are pending in the present application and currently stand rejected.

Claims 1-10 and 18-19 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,909,545 to Frese (hereinafter "Frese"). This same rejection was raised in the Office Action dated July 22, 2005, and was overcome by applicant's response filed on November 25, 2005.

The present invention relates to a server-based computing system, including at least one server (1) and at least one client computer (5), connected to the server (1) through a network (2). The server (1) includes means for providing the client computer (5) with a user interface and means for running the application. The system also includes means for controlling the locally run applications through the user interface provided by the server (1), and is configured to enable the server (1) to control the display on a screen of the display device (7) of a screen area having contents generated locally on the client computer.

Frese does not disclose the limitation of claim 1 requiring "the client computer…is configured to enable the server…to control the display on a screen of the display device of a screen area having contents generated locally on the client computer." The Examiner erroneously concludes that because Frese's client computer (16) is connected to server (20) via a network, Frese's computer is "configured to" enable server (20) to control the display on a screen area on a display having contents generated locally on client computer (16), as claimed. However, merely connecting a client computer (16) to a server (20) is not sufficient because the server must have a means for controlling the display of the local client computer. See p. 11, lines 3-6 of the specification and *Boston Sci. Corp. v. Cordis Corp.*, 2006 U.S. Dist. LEXIS 94329 (D. Cal. 2006) (copy enclosed). *Boston Scientific* interpreted "configured to" as "intentionally and specifically made to act in a certain way." Without means

intentionally and specifically made to control the display of the local computer, Frese does not meet claim 1.

Instead, Frese uses an applet (Remote Display Module (RDM) 18) running on a client for this purpose, and thus not the server. See col. 9, line 63 to col. 10, line 4. The HTML page described at col. 7, lines 33-35 of Frese, is not an application that is run locally. It is only provided for describing "available application programs". See col. 7, lines 33-35. The other modules running on the server do not specify display properties of an interface to an application running locally on the client. Frese discloses that an AIM (application interception module) converts the I/O streams for the application launched on the RAS (remote application server) into remote control protocol messages, see col. 13, lines 60-63, and that a protocol translation and optimisation module (PTOM) encapsulates known remote control protocol messages in the remote control protocol recognized by the RDM. See col. 8, lines 46-48. The AIM, PTOM and RDM each play a role in controlling applications running on the server, but do not control the display of a user interface which can control an application running locally on the client computer. For these reasons the limitations of claim 1 are not met by Frese.

The Examiner says that server 20 of Frese controls the display as required by claim 1 by specifying the parameters of RDM applet 18. This is incorrect. Rather, RDM applet 18 of Frese controls the display of a screen area not server 20 (col. 6, lines 60-64). The RDM applet 18 of Frese executes on user system 16 (col. 6, lines 61-62) and thus user system 16 controls the display by executing the RDM. Frese does disclose that the server specifies RDM applet 18's parameters, as the Examiner suggests. Rather, the executable code for RDM applet 18 is transported in a file across the network prior to execution on user system 16 (col. 9, lines 61-66). Also, the applet tag of the HTML document is used to select RDM applet 18 to transmit to the local computer and not to control display parameters (see col. 10, lines 5-14). RDM applet 18 of Frese does not generate content since an application window, as relied on by the Examiner, is not content. Rather, RDM applet 18 controls a display and receives user input actions to generate and provide output to local resource interface 32 (col. 9, line 66 to col. 10, line 4). Finally, even when RDM applet 18 displays content generated locally (e.g. user input to RDM applet 18), this does not involve server 20 and thus the display of the locally generated content is not controlled by server 20.

Claim 18 requires that the server controls the display on a screen of the display device. Accordingly, for the reasons discussed above with respect to claim 1, claim 18 is novel over Frese since Frese does not disclose that server 20 controls the display, but rather Frese discloses that RDM applet 18 executed on client computer 16 controls the display.

Frese does not anticipate claim 19 since Frese does not disclose a computer program that, when run on the computer, causes the computer to accept a user interface for controlling the locally run

applications, provided by the server and to display a screen area having contents generated locally on the client computer according to display properties specified by the server. The Examiner alleges that in Frese a web page can be the claimed user interface. This is incorrect because the Examiner ignores the claim language requiring that the user interface control locally run applications. Browser 30 generated by RDM applet 18 of Frese is the user interface since it controls applications (col. 7 lines 16-27). Frese does not disclose a web page that controls applications. Accordingly, the user interface of Frese, browser 30, is not controlled or provided by server 20, but is controlled and provided by local computer 16 via RDM applet 18. Thus, Frese does not disclose that the display properties of the interface are specified by the server 20, as required by claim 19.

The Examiner also says that the display properties of Frese are the applet parameters specified in an applet tag. However, this is not the case. The applet tags of Frese do not control the display properties since the applet tags are only used to select the proper RDM applet 18 to transmit to the local computer to control the display properties (col. 10, lines 5-14 of Frese).

Claims 1-10 and 18-19 have been rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 5,613,090 to Willems (hereinafter "Willems"). Willems discloses a personal computer in a computer network which is capable of seamlessly running disparate graphical user interfaces (GUIs) without requiring extraneous system resources (col. 1, lines 9-13). Willems discloses running Microsoft Windows® and X-Windows® applications simultaneously. Willems provides a consistent and uniform user interface when a client runs applications under two different operating systems with the Microsoft Windows® application running locally and the X-Windows® application running on a server.

The Examiner admits that the prior art embodiment of Fig. 8 of Willems lacks two elements of claim 1, namely: (1) controlling locally run applications through the user interface provided by the server (p. 14 of the Final Rejection), and (2) means for locally running at least one application (p. 14 of the Final Rejection). The Examiner would modify Fig. 8 of Willems to locate window manager 100 to on the same computer as X server 102 to arrive at missing element (1). This proposed modification is not consistent with the teachings of Willems which relies on the same reasoning to modify the prior art embodiment of Fig. 8 to arrive at the embodiment of Fig. 9, and not the configuration proposed by the Examiner. The embodiment of Fig. 9 does not meet the limitations of the present claim 1.

The other problem with this proposed modification of the embodiment of Fig. 8 is the same problem that led to the withdrawal of the previous rejection over Willems, namely, that such a modification will increase network traffic. In the configuration proposed by the Examiner, the window manager 100 of Fig. 8 running on the server will have to send commands over the network in order to control locally run applications through the user interface on the local computer. Note that the Fig. 9

embodiment of Willems overcomes this problem by placing both window manager 100 and X Windows on the local computer. Accordingly, the Examiner's proposed modification directly contradicts the primary stated goal of Willems which is to reduce network traffic since this arrangement would increase network traffic as compared to the solution offered in Fig. 9 of Willems. (col. 13, line 67 to col. 14, line 4 of Willems and the Field of the Invention at col. 1, lines 9-13 state that, "The present invention is related to… a personal computer network which is capable of seamlessly running disparate GUIs [graphical user interfaces] and their applications without requiring extraneous system resources." (emphasis added).

The Examiner attempts to argue that the primary stated goal of Willems applies only to Fig. 9 but not to Fig. 8 since Fig. 8 is a prior art embodiment. However, the Examiner relies on other stated goals of Willems that also apply to Fig. 9 for motivation to make modifications to the embodiment of Fig. 8 e.g. col. 14, ll. 1-5 – reducing front end code), while at the same time ignoring the primary stated goal of Willems to reduce network traffic. Willems must be considered as a whole and thus a skilled person would not selectively rely on the reduced code goal of Willems without considering the primary goal, as the Examiner does.

The Examiner also alleges that it would be obvious in the embodiment of Fig. 8 of Willems to provide means on the client computer for locally running at least one further application on the basis that this will reduce the amount of front end code required, citing col. 14, ll. 1-5. This would also increase network traffic in the Examiner's proposed configuration because local control of this application would require this means to send commands over the network because the Examiner has located the user interface (windows manager 100) on the server. Thus, the skilled person, desiring to reduce network traffic would not provide means on the client computer to run applications since this would increase network traffic.

The Examiner also concludes that Willems is configured to enable the server to control the display on a screen of the display device because Willems' client computer is connected to the server via a network. The same arguments given above for Frese also apply to this argument in relation to Willems.

Willems indicates that the window manager 100 of prior art Figure 8 can be run remotely (col. 13, lines 40-58). Figure 8 of Willems shows the Window manager 100 and the X server 102 as two separate elements. Willems also states that running the window manager 100 remotely increases network traffic between Window manager 100 and the X server 102 (col. 13, lines 53-58). Thus, even when window manager 100 is run remotely, it is not run on the X server 102. Thus, in the embodiment of Fig. 8 of Willems, the user interface is not being provided by X server 102, but instead is provided by window manager 100, which is connected to the X server via the network. Accordingly, Willems completely lacks a teaching, even in Fig. 8, to configure the server to provide the user interface, as is

required by the present claim 1. The Examiner also says on p. 9, item 4 of the Final Rejection that it is obvious to enable window manager 100 to control locally run applications to reduce front-end code citing col. 14, ll. 1-5 of Willems. However, this part of Willems says that front-end code is reduced when control of locally run applications is local. In the Examiner's configuration, window manager 100 is on the server and thus not local so this reasoning also fails.

The embodiment of Fig. 8 of Willems does not disclose the following elements of claim 18: (1) controlling locally run applications through the user interface provided by the server, and (2) means for locally running at least one application. Again, the skilled person would not modify the embodiment of Fig. 8 of Willems, with the window manager 100 run remotely, to include either of these two missing features since such modifications would increase network traffic, thereby directly contradicting the stated goal of Willems to decrease network traffic.

As for Frese above, claim 18, as amended, requires the server to control the display on a screen of the client computer. The Examiner says that the embodiment of Fig. 8 of Willems teaches this element of claim 18 on the basis that window manager 100, when run remotely, meets this limitation. However, as discussed above, Fig. 8 of Willems and the description thereof make it clear that even when window manager 100 is run remotely, it is not run on X server 102 of Willems, but rather is connected to X server 102 of Willems via the network (col. 13, lines 53-58) and thus X server 102 of Fig. 8 does not control the display as required by claim 18.

As above, Fig. 8 of Willems does disclose the following elements of claim 19:(1) controlling locally run applications through the user interface provided by the server, and (2) means for locally running at least one application. Again, the skilled person would not modify the embodiment of Fig. 8 of Willems, to run window manager 100 on the server, to include either of these two missing features of claim 19 since such modifications would increase network traffic, thereby directly contradicting the stated goal of Willems. In addition, the Examiner admits that Willems also lacks a third element of claim 19, namely, (3) that the computer program, when run on the computer, causes the computer to display a screen area having contents generated locally on the client computer according to display properties specified by the server. Nowhere does Willems teach that the windows manager 100 should be located on the server. Thus, Willems does not teach that the display on the client computer is generated according to display properties specified by the server.

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Respectfully submitted,

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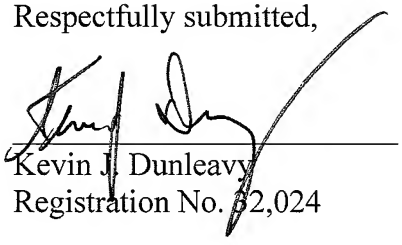

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